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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/575,131

05/23/2000

Paul Lapstun

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10/01/2004

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,131

Applicant(s)

LAPSTUN ET AL.

Examiner

Saeid Ebrahimi-dehKordy

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. Applicant's arguments with respect to claim 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,5-6,8-10,13 and 15-16 rejected under 35 U.S.C. 102(b) as being anticipated by Li et al (U.S. patent 5,506,697)

Regarding claim 1 and 10 Li et al disclose: A method for providing, a mailing system, including the steps of receiving, through a computer system a mail item from a sender (please note column 8 lines 42-48 and column 8 lines 49-55) printing the mail item in a document including coded data thereon (please note column 4 lines 9-28) the coded data including an indication of the identity of the mail item and of the location of at least one reference point on the document (please note column 3 lines 46-60) receiving in the computer system indicating data from an optically imaging sensing device (please note column 4 lines 9-12 and also column 8 lines 57-62) the indicating data including information regarding the identity of the mail item and at least one action of the sensing device in relation to the document generated by the sensing device optically reading at least some of the coded data printing on the document; and

generating a second mail item using said indicating data from the sensing device
(please note column 8 lines 49-65).

Regarding claim 5 and 13 Li et al disclose: The method of claim 1, wherein the mail item is printed automatically on receipt by a terminal device including a printer
(please note column 6 lines 47-52)

Regarding claim 6 Li et al disclose: The method of claim 5, wherein the terminal device is at the premises of the receiver (please note column 7 lines 47-67 and column 8 lines 1-3).

Regarding claim 8 and 15 Li et al disclose: The method of claim 1, including printing the coded data so as to be at least substantially invisible in the visible spectrum
(please note column 8 lines 49-65)

Regarding claim 9 and 16 Li et al disclose: The method of claim 8, wherein the mail item is printed on the document at the same time as the coded data (please note column 7 lines 46-67 and column 8 lines 1-3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4,7,11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al (U.S. patent 5,506,697) in view of Uchida et al (U.S. patent 6,327,610)

Regarding claim 2 Li et al do not disclose: The method of claim 1, wherein the indicating data includes information regarding an identity of the sensing device. On the other hand Uchida et al disclose: The method of claim 1, wherein the indicating data includes information regarding an identity of the sensing device (please note column 4 lines 37-41) Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Li et al's invention according to the teaching of Uchida et al, Uchida et al in the same field of endeavor teach the way the communication server which is the sensing device is coded in the mail item for purpose of identifying the server identity.

Regarding claim 3 and 12 Uchida et al disclose: The method of claim 2, wherein the second mail message is generated using the information regarding the identity of the sensing device to indicate the receiver as originator of the second mail item (please note column 8 lines 52-60).

Regarding claim 4 Uchida et al disclose: The method of claim 2 or 3, wherein the second mail item is directed to the sender (please note column 8 lines 43-61).

Regarding claim 7 and 14 Uchida et al disclose: The method of claim 1, wherein the at least one action of the sensing device in relation to the registration form includes the formation of handwritten text and/or markings on the document (please note column 6 lines 62-67 and column 7 lines 1-5).

Regarding claim 11 Uchida et al disclose: The system of claim 10, wherein the sensing device includes an identification means that imparts a unique identity to the

sensing device and the indicating data includes information regarding the identity of the sensing device (please note column 6 lines 62-67 and column 7 lines 1-5).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

➤ Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Art Unit: 2626

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark

"EXPEDITED PROCEDURE")

Or:

(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy

Patent Examiner

Group Art Unit 2626

September 27 2004



KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER